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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/849,504

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William Donovan Quigg

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ART UNIT

PAPER NUMBER

3622

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Office Action Summary

Application No.

09/849,504

Applicant(s)

QUIGG, WILLIAM DONOVAN

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-64 have been examined. Application 09/849,504 has a filing date 05/04/2001 Claims Priority from Provisional Application 60/202,583 (05/09/2000).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 34-64 are not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found

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that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

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§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claims 34, 49, 52, 57 and 61 recite a “useful, concrete and tangible result” (providing paper product with promotional material), however the claims recite no structural limitations (i.e., computer implementation), and so they fail the first prong of the test (technological arts). Dependent claims 35-48, 50, 51, 53-56, 58-60 and 62-64 do not remedy this situation as no structural limitations are recited.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zorn (U.S. 6,129,346) in view of Loeb et al (U.S. 6,421,652).

As per claim 1, Zorn teaches:

A computer system for processing a paper product, comprising:

a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer, the paper product including a roll of paper or a plurality of unbound, stacked paper sheets

(see column 3, lines 20-51)

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a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product or in an enclosure for the paper product (see column 2, lines 33-62; column 5, line 63 – column 6, line 34; column 8, lines 12-25); and

a paper product tracker configured to provide instructions for creating an enclosure for the paper product, the enclosure having or enclosing the promotional material of the received promotional material order, the paper product tracker further being configured to provide instructions to enclose the paper product of the received order with the created enclosure, wherein the paper manufacturer, the paper purchaser, and the third-party advertiser are different entities (see column 2, lines 33-62; column 5, line 63 – column 6, line 34; column 8, lines 12-25); and

Zorn fails to teach the third-party advertiser pays to have the promotional material placed on or enclosed by the enclosure of the paper product. However, Loeb teaches that advertisers are willing to pay high fees to display their advertisements within the pages of printed publications (see column 1, lines 41-56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers using the Zorn system would pay advertisements' fees to display their advertisements within the pages of publishers' printed publications, as taught by Loeb. Publishers of printed publications would receive advertisements' revenues by allowing advertisers to display their advertisements within the pages of the publishers' printed publications.

As per claim 2, Zorn and Loeb teaches:

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The computer system of claim 1, further comprising a remuneration tracker configured to track remuneration paid by the third-party advertiser for the promotional material. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if the Zorn system tracks the effectiveness of the advertisers' promotional material placed within the pages of publishers' printed publications (see column 6, lines 15-30), then, it would also track and bill the advertisers that are benefiting from inserting their promotional materials within the pages of the publishers' printed publications.

As per claim 3, Zorn and Loeb teaches:

The computer system of claim 1, further comprising an artwork tracker configured to provide instructions for creating a fixed medium that includes the promotional material (see Zorn column 8, lines 12-20).

As per claim 4, Zorn and Loeb teaches:

The computer system of claim 1 wherein the promotions order tracker is configured to coordinate enclosing the paper product with a particular enclosure based on the content of the promotional material, the identity of the paper purchaser, and/or a location to which the paper product is to be delivered (see Zorn column 4, lines 6-65).

As per claim 5, Zorn and Loeb teaches:

The computer system of claim 1 wherein the promotional material order is a first promotional material order for first promotional material and the third-party advertiser is

a first third party advertiser, and wherein the promotions order is a first order for

receive a second promotional material order from a second third-party advertiser to place second promotional material on the enclosure (see Zorn column 6, lines 10-30).

As per claim 6, Zorn and Loeb teaches:

The computer system of claim 1 wherein the product order tracker is configured to receive a paper product order for unbound, stacked sheets of paper and/or a roll of paper (see column 3, lines 39-51).

As per claim 7, Zorn and Loeb teaches:

The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose unbound stacked sheets of paper (see column 3, lines 40-51).

As per claim 8, Zorn and Loeb teaches:

The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose a roll of paper (see column 3, lines 13-50).

As per claim 9, Zorn and Loeb teaches:

The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for an advertisement placed on a box configured to enclose the paper product (see column 8, lines 12-20).

As per claim 10, Zorn and Loeb teaches:

The computer system of claim 1 wherein the promotions order tracker is configured to receive an order for a coupon placed on or enclosed by the enclosure

As per claim 11, Zorn and Loeb teaches:

A method in a computer system for preparing a paper product, the method comprising:

receiving a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer (see column ;

receiving a promotions order from a third-party advertiser to place promotional material on or in an enclosure of a paper product;

enclosure having or enclosing the promotional material of the received promotions order, and providing instructions to enclose the paper product of the received order with the created enclosure; and

providing instructions to deliver the paper product enclosed with the created enclosure to a delivery location, wherein the paper manufacturer, the paper purchaser, and the third-party advertiser are different entities and the third-party advertiser pays to have the promotional material placed on or enclosed by the enclosure of the paper product. The same rejection applied to claim 1 is applied to claim 11.

As per claim 12, Zorn and Loeb teaches:

The method of claim 11 wherein receiving a paper product order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the paper purchaser. Loeb teaches that 60% of all new subscriptions are acquired by third-party service providers (see column 2, lines 10-20). Therefore, it would have been obvious to a person of ordinary skill in the art the time the application was made, to know that Zorn would use intermediary parties (i.e., agents) that would work to

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bring more subscribers to the publishers' printed publication. The publishers would need the subscribers' fees and the advertisements' fees to pay for the expenses incurred in producing the printed publication.

As per claim 13, Zorn and Loeb teaches:

The method of claim 11 wherein receiving a promotions order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the third-party advertiser. The same rejection applied to claim 12 is applied to claim 13.

As per claim 14, Zorn and Loeb teaches:

The method of claim 11, further comprising tracking receipt of remuneration from the third-party advertiser for the promotional material. The same rejection applied to claim 2 is applied to claim 14.

As per claim 15, Zorn and Loeb teaches:

The method of claim 11, further comprising tracking receipt of remuneration from the third-party advertiser to an intermediate party for the promotional material. The same rejection applied to claims 13 and 14 is applied to claim 15.

As per claim 16, Zorn and Loeb teaches:

The method of claim 11, further comprising tracking receipt of remuneration from the paper purchaser for the paper product (see column 6, lines 10-35).

As per claim 17, Zorn and Loeb teaches:

The method of claim 11, further comprising tracking receipt of remuneration from the paper purchaser to an intermediate party for the paper product (see column 6, lines 10-35).

As per claim 18, Zorn and Loeb teaches:

A computer system for tracking a transaction among a paper manufacturer, a paper purchaser, and a third-party advertiser, the computer system comprising:

a paper order tracker configured to track an order from the paper purchaser for purchase of a plurality of unbound, stacked paper sheets produced by the paper manufacturer;

an advertisement order tracker configured to track an order from the third-party advertiser for an advertisement placed on a wrapper configured to at least partially enclose and the protect the plurality of unbound, stacked paper sheets;

a first remuneration tracker configured to track payment of a first remuneration from the paper purchaser for purchase of the paper; and

a second remuneration tracker configured to track payment of a second remuneration from the third-party advertiser for the advertisement. The same rejection applied to claims 11, 14 and 16 is applied to claim 18.

As per claim 19, Zorn and Loeb teaches:

The computer system of claim 18 wherein the advertisement order tracker is configured to instruct an intermediate party to place the advertisement on the wrapper. The same rejection applied to claim 13 is applied to claim 19.

As per claim 20, Zorn and Loeb teaches:

The computer system of claim 18 wherein the first remuneration tracker is configured to track the receipt of the first remuneration from the paper purchaser for purchase of the paper. The same rejection applied to claim 16 is applied to claim 20.

As per claim 21, Zorn and Loeb teaches:

The computer system of claim 18 wherein the second remuneration tracker is configured to track receipt of the second remuneration from the third-party advertiser for the advertisement. The same rejection applied to claim 14 is applied to claim 21.

As per claim 22, Zorn and Loeb teaches:

A computer system for tracking a transaction among a paper product manufacturer, a paper product purchaser, and a third-party advertiser, the computer system comprising:

- an order tracker capable of tracking an order from the third-party advertiser for promotional material placed on or enclosed by an enclosure configured to at least partially

- stacked paper sheets produced by the paper product manufacturer or a roll of paper produced by the paper product manufacturer, the enclosure including a wrap or a carton configured to at least partially surround the paper product; and

- a remuneration tracker capable of tracking remuneration paid by the third-party advertiser for the promotional material and updating a database to indicate receipt of the remuneration. The same rejection applied to claim 22 is applied to claim 18.

As per claim 23, Zorn and Loeb teaches:

The computer system of claim 22 wherein the remuneration tracker is configured to track remuneration received from the third-party advertiser for the promotional material. The same rejection applied to claim 21 is applied to claim 23.

As per claim 24, Zorn and Loeb teaches:

The computer system of claim 22 wherein the order tracker is configured to track an order for an advertisement placed on an external surface of a wrapper configured to enclose a ream of paper. The same rejection applied to claim 8 is applied to claim 24.

As per claim 25, Zorn and Loeb teaches:

The computer system of claim 22 wherein the order tracker is configured to track an order for a coupon disposed on or in the enclosure. The same rejection applied to claim 10 is applied to claim 25.

As per claim 26, Zorn and Loeb teaches:

A computer-readable medium, the contents of which perform a method for tracking a transaction among a paper product manufacturer, a paper product purchaser, and a third-party advertiser, the method comprising:

receiving an indication of an order from the third-party advertiser for promotional material placed on or enclosed by an enclosure configured to at least partially enclose and the protect a paper product, the paper product including a plurality of unbound, stacked paper sheets produced by the paper product manufacturer, or a roll of paper produced by the paper product manufacturer, the enclosure including a wrap or a carton configured to at least partially surround the paper product;

updating a database to indicate receipt of the order;

receiving an indication that remuneration has been paid by the third-party advertiser for the promotional material; and
updating the database to indicate payment of the remuneration. The same rejection applied to claim 18 is applied to claim 26.

As per claim 27, Zorn and Loeb teaches:

The computer-readable medium of claim 26 wherein the method further comprises:

receiving an indication that remuneration has been received from the third party advertiser for the promotional material; and
updating the database to indicate receipt of the remuneration. The same rejection applied to claim 21 is applied to claim 27.

As per claim 28, Zorn and Loeb teaches:

The computer-readable medium of claim 26 wherein receiving an indication of an order includes receiving an indication of an order for an advertisement disposed on an external surface of a ream wrapper. The same rejection applied to claim 8 is applied to claim 28.

As per claim 29, Zorn and Loeb teaches:

The computer-readable medium of claim 26 wherein the method further comprises providing instructions to create an enclosure for the paper product, the enclosure having or enclosing the promotional material of the received promotions order, and providing instructions to enclose the paper product of the received order with the created enclosure. The same rejection applied to claim 1 is applied to claim 29.

As per claim 30, Zorn and Loeb teaches:

The computer-readable medium of claim 26 wherein the method further comprises providing instructions to deliver the paper product enclosed with the created enclosure to a delivery location. The same rejection applied to claim 4 is applied to claim 30.

As per claim 31, Zorn and Loeb teaches:

A method for selling paper products over a computer network, comprising:

receiving an order for a paper product from a purchaser over a computer network, the paper product including unbound stacked sheets of paper or a roll of paper; and filling the order with a paper product manufactured by a paper product manufacturer, the paper product being at least partially enclosed by a protective enclosure, the enclosure having or enclosing promotional material configured to identify and/or promote goods and/or services of a third party different from the manufacturer and different from the purchaser, wherein an identity of the purchaser is withheld from the paper product manufacturer and an identity of the paper product manufacturer is withheld from the purchaser. The same rejection applied to claim 18 is applied to claim 31.

As per claim 32, Zorn and Loeb teaches:

The method of claim 31 wherein filling the order includes providing a ream of paper wrapped with a ream wrap having an advertisement promoting goods and/or services of the third party. The same rejection applied to claims 18 and 21 is applied to claim 32.

As per claim 33, Zorn and Loeb teaches:

The method of claim 31 wherein filling the order includes providing a coupon disposed on or in the enclosure. The same rejection applied to claim 10 is applied to claim 33.

As per claim 34, Zorn and Loeb teaches:

A method for providing paper products with promotional materials, comprising:
receiving an order from a purchaser for a paper product, the paper product including unbound stacked sheets of paper or a roll of paper;
manufacturing the paper product;
providing instructions for disposing promotional material on or in an enclosure configured to at least partially enclose and protect the paper product, the promotional material being requested by a third party;
providing instructions for disposing the paper product within the enclosure;
providing instructions for disbursing a first remuneration from the purchaser; and
providing instructions for disbursing a second remuneration from the third party advertiser for the promotional material. The same rejection applied to claim 18 is applied to claim 34.

As per claim 35, Zorn and Loeb teaches:

The method of claim 34, further comprising receiving the first remuneration from the purchaser. The same rejection applied to claim 18 is applied to claim 35.

As per claim 36, Zorn and Loeb teaches:

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The method of claim 34, further comprising receiving the second remuneration from the third-party advertiser. The same rejection applied to claim 18 is applied to claim 36.

As per claim 37, Zorn and Loeb teaches:

The method of claim 34, further comprising disposing the promotional material on the enclosure before disposing the paper product within the enclosure. The same rejection applied to claim 18 is applied to claim 37.

As per claim 38, Zorn and Loeb teaches:

The method of claim 34, further comprising disposing the promotional material on the enclosure after disposing the paper product within the enclosure. The same rejection applied to claim 18 is applied to claim 37.

As per claim 39, Zorn and Loeb teaches:

The method of claim 34, further comprising receiving an order from the third-party advertiser for the promotional material. The same rejection applied to claim 18 is applied to claim 39.

As per claim 40, Zorn and Loeb teaches:

The method of claim 34 wherein providing instructions for disposing promotional material includes providing instructions for printing an advertisement on an external surface of the enclosure (see column 6, lines 10-67).

As per claim 41, Zorn and Loeb teaches:

The method of claim 34 wherein providing instructions for disposing promotional material includes providing instructions for providing coupons configured to be disposed within the enclosure. The same rejection applied to claim 10 is applied to claim 41.

As per claim 42, Zorn and Loeb teaches:

The method of claim 34 wherein providing instructions for disposing promotional material on or in an enclosure includes providing instructions for disposing promotional material on a ream wrap configured to enclose a ream of paper. The same rejection applied to claim 24 is applied to claim 42.

As per claim 43, Zorn and Loeb teaches:

The method of claim 34 wherein providing instructions for disposing promotional material on or in an enclosure includes providing instructions for disposing promotional material on a roll wrap configured to enclose a roll of paper. The same rejection applied to claim 1 is applied to claim 43.

As per claim 44, Zorn and Loeb teaches:

The method of claim 34 wherein providing instructions for disposing promotional material on or in an enclosure includes providing instructions for disposing promotional material on a skid wrap configured to enclose a stack of unbound paper on a skid. The same rejection applied to claim 1 is applied to claim 44.

As per claim 45, Zorn and Loeb teaches:

The method of claim 34 wherein providing instructions for disposing promotional material on or in an enclosure includes providing instructions for disposing promotional

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material on a carton configured to contain the paper product. The same rejection applied to claim 1 is applied to claim 45.

As per claim 46, Zorn and Loeb teaches:

The method of claim 34 wherein providing instructions for disbursing a first remuneration from the purchaser includes directing the first remuneration to be paid to an intermediate party. The same rejection applied to claim 19 is applied to claim 46.

As per claim 47, Zorn and Loeb teaches:

The method of claim 34 wherein providing instructions for disbursing a second remuneration from the third-party advertiser for the promotional material includes directing the second remuneration to be paid to an intermediate party. The same rejection applied to claim 19 is applied to claim 47.

As per claim 48, Zorn and Loeb teaches:

The method of claim 34, further comprising instructing another entity to dispose the promotional material on the enclosure. The same rejection applied to claim 19 is applied to claim 48.

As per claim 49, Zorn and Loeb teaches:

A method for providing paper products with promotional materials, comprising:

receiving an order from a purchaser for a ream of paper;

receiving an order from a third-party advertiser for an advertisement placed on a wrapper configured to at least partially enclose and protect the ream of paper;

wrapping the ream of paper with the wrapper, the wrapper having the advertisement and at least partially enclosing and protecting the ream of paper;

receiving a first remuneration from the purchaser for the ream of paper; and receiving a second remuneration from the third-party advertiser for the advertisement on the wrapper. The same rejection applied to claim 18 is applied to claim 49.

As per claim 50, Zorn and Loeb teaches:

The method of claim 49, further comprising instructing an intermediate party to place the advertisement on the wrapper. The same rejection applied to claim 19 is applied to claim 50.

As per claim 51, Zorn and Loeb teaches:

The method of claim 49, further comprising selecting the wrapper for the ream based on the content of the advertisement, the identity of the purchaser, and/or a location to which the ream is to be delivered. The same rejection applied to claim 4 is applied to claim 51.

As per claim 52, Zorn and Loeb teaches:

A package of paper products, comprising:

a plurality of stacked, unbound paper sheets produced by a paper sheet manufacturer and purchased by a paper purchaser;

a wrapper disposed around the plurality of paper sheets, the wrapper being positioned to at least partially enclose and protect the plurality of paper sheets; and promotional material disposed on the wrapper, the promotional material having a content configured to identify and/or promote goods and/or services of a third-party

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advertiser different from the manufacturer and different from the paper purchaser. The same rejection applied to claim 18 is applied to claim 52.

As per claim 53, Zorn and Loeb teaches:

The package of claim 52 wherein the promotional material includes an advertisement. The same rejection applied to claim 18 is applied to claim 53.

As per claim 54, Zorn and Loeb teaches:

The package of claim 52 wherein the third-party advertiser is a first third-party advertiser and the promotional material includes a first advertisement configured to identify and/or promote goods and/or services of the first third-party advertiser, and wherein the promotional material further includes a second advertisement configured to identify and/or promote goods and/or services of a second third-party advertiser. The same rejection applied to claim 18 is applied to claim 54.

As per claim 55, Zorn and Loeb teaches:

The package of claim 52 wherein the promotional material includes a coupon. The same rejection applied to claim 10 is applied to claim 55.

As per claim 56, Zorn and Loeb teaches:

The package of claim 52 wherein the plurality of stacked, unbound paper sheets includes a ream of paper. The same rejection applied to claim 24 is applied to claim 56.

As per claim 57, Zorn and Loeb teaches:

an elongated sheet of paper rolled upon itself to form a paper roll, the elongated sheet of paper being produced by a paper sheet manufacturer and purchased by a paper purchaser;

a wrapper disposed around the paper roll, the wrapper being positioned to at least partially enclose and protect the paper roll; and

a content configured to identify and/or promote goods and/or services of a third-party advertiser different from the manufacturer and different from the paper purchaser.

The same rejection applied to claim 1 is applied to claim 57.

As per claim 58, Zorn and Loeb teaches:

The packaged roll of claim 57 wherein the promotional material includes an advertisement. The same rejection applied to claim 2 is applied to claim 58.

As per claim 59, Zorn and Loeb teaches:

The packaged roll of claim 57 wherein the third-party advertiser is a first third-party advertiser and the promotional material includes a first advertisement configured to identify and/or promote goods and/or services of the first third-party advertiser, and wherein the promotional material further includes a second advertisement configured to identify and/or promote goods and/or services of a second third-party advertiser. The same rejection applied to claim 2 is applied to claim 59.

As per claim 60, Zorn and Loeb teaches:

The packaged roll of claim 57 wherein the promotional material includes a coupon. The same rejection applied to claim 10 is applied to claim 60.

As per claim 61, Zorn and Loeb teach

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A package of paper products, comprising:

a plurality of unbound paper sheets produced by a paper sheet manufacturer and purchased by a paper purchaser;

a carton in which the plurality of paper sheets is positioned, the carton at least partially enclosing and protecting the paper sheets; and

promotional material disposed on the carton, the promotional material having a content configured to identify and/or promote goods and/or services of a third-party advertiser different from the paper sheet manufacturer and the paper purchaser. The same rejection applied to claim 1 is applied to claim 61.

As per claim 62, Zorn and Loeb teaches:

The package of claim 61 wherein the promotional material includes an advertisement. The same rejection applied to claim 2 is applied to claim 62.

As per claim 63, Zorn and Loeb teaches:

The package of claim 61 wherein the third-party advertiser is a first third-party advertiser and the promotional material includes a first advertisement configured to identify and/or promote goods and/or services of the first third-party advertiser, and identify and/or promote goods and/or services of a second third-party advertiser. The same rejection applied to claim 2 is applied to claim 63.

As per claim 64, Zorn and Loeb teaches:

The package of claim 61 wherein the promotional material includes a coupon.

The same rejection applied to claim 10 is applied to claim 64.

Conclusion


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
November 24, 2004


Rafael Alvarez
Primary Examiner
Art Unit 3622